

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN D. CULHANE

Appeal 2006-3161
Application 10/687,228
Technology Center 3700

Decided: August 30, 2007

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and LINDA E. HORNER Administrative Patent Judges.

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

31 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
32 of claims 10 to 19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

33 Appellant invented a garment to be worn by a human being
34 (Specification 1).

1 Claim 10 under appeal reads as follows:

2 10. A garment to be worn by a human being
3 comprising:

5 a front portion and a rear portion;

7 a pair of arms being joined to said front and rear portions;

9 each of said arms having an outer elbow portion formed
10 from a stretch fabric material and other portions formed
11 from a non-stretch fabric material; and

13 underarm portions formed from a stretch fabric material.

15 The Examiner rejected claims 10 to 19 under 35 U.S.C. § 112, first
16 paragraph, because the specification does not reasonably provide enablement
17 for defining a non-stretch fabric material.

18 The Examiner rejected claims 10 to 13 under 35 U.S.C. § 102(b) as
19 being anticipated by Kratz.

20 The Examiner rejected claims 14 to 16 under 35 U.S.C. § 103(a) as
21 being unpatentable over Kratz in view of Blauer.

22 The Examiner rejected claims 17 to 19 under 35 U.S.C. § 103(a) as
23 being unpatentable over Kratz in view of Lipson.

24 The prior art relied upon by the Examiner in rejecting the claims on
25 appeal is:

26 Lipson	US 2,002,955	May 28, 1935
27 Kratz	US 4,722,099	Feb. 2, 1988
28 Blauer	US 5,593,754	Jan. 14, 1997

30 Appellant contends that the Examiner has not made out a case of non-
31 enablement because the Examiner has not established or averred that the

1 present invention could only be made with a significant amount of
2 experimentation (Brief p. 5).

3 Appellant further contends that Kratz does not disclose outer elbow
4 portions formed from a stretch fabric material (Brief p. 8).

5

6 ISSUES

7 The first issue is whether the Appellant has shown that the Examiner
8 erred in holding that the recitation in claim 10 of a “non-stretch” fabric
9 material does not satisfy the requirements of the enablement portion of the
10 first paragraph of 35 U.S.C. § 112.

11 The second issue is whether the Appellant has shown that the
12 Examiner erred in finding that Kratz discloses an outer elbow portion
13 formed from a stretch fabric material.

14

15 FINDINGS OF FACT

16 The Appellant discloses and claims a garment with outer elbow
17 portions 86, 88 formed of stretch fabric material (Claim 10; Specification, p.
18 8; Figure 5).

19 Kratz discloses a garment to be worn by a human being having
20 portions of the garment formed of mesh material and portions of the garment
21 comprised of natural or artificial leather (col. 1, ll. 63 to 67). The Examiner
22 is of the opinion that the mesh material is a stretch material and that this
23 mesh material is formed in the outer elbow portions.

24 Kratz teaches that the mesh material is located from the armpits
25 forward on the chest, rearward toward the back, and on the inside elbows
26 and the neck (col. 1, l. 61 to col. 2, l. 1). Kratz does not disclose that the

1 outer elbow portions are formed of mesh material. In fact, Kratz discloses
2 that the outer elbow is formed of natural or artificial leather and may be
3 provided with reinforcing patches (Figure 3; col. 3, ll. 27 to 28; col. 7, ll. 12
4 to 18).

5 **PRINCIPLES OF LAW**

6 An analysis of whether the claims under appeal are supported by an
7 enabling disclosure requires a determination of whether that disclosure
8 contains sufficient information regarding the subject matter of the appealed
9 claims as to enable one skilled in the pertinent art to make and use the
10 claimed invention. The test for enablement is whether one skilled in the art
11 could make and use the claimed invention from the disclosure coupled with
12 information known in the art without undue experimentation. See *United*
13 *States v. Telelectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed.
14 Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d
15 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

DISCUSSION

We will not sustain the Examiner’s rejection of claims 10 to 19 under the enablement requirement of the first paragraph of 35 U.S.C. § 112 because the Examiner has not established that a person of ordinary skill in the art would not be able to make or use the claimed garment with non-stretch fabric material without undue experimentation. In fact, the Examiner has not even discussed undue experimentation. In addition, in our view a person of ordinary skill in the art would know how to make a non-stretch fabric material (See Appendix D to the Appeal Brief).

We will not sustain the Examiner’s prior art rejections because each of the rejections relies on Kratz for teaching a stretch material in the outer elbow portion of the garment. Even if we were to agree with the Examiner that the mesh material disclosed in Kratz is a stretch material, such mesh material is not disposed in the outer elbow portion of the garment.

REVERSED

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24 BACHMAN & LAPOINT
25 900 CHAPEL STREET
26 SUITE 1201
27 NEW HAVEN CT 06510

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DISCUSSION

2 We will not sustain the Examiner’s rejection of claims 10 to 19 under
3 the enablement requirement of the first paragraph of 35 U.S.C. § 112
4 because the Examiner has not established that a person of ordinary skill in
5 the art would not be able to make or use the claimed garment with non-
6 stretch fabric material without undue experimentation. In fact, the Examiner
7 has not even discussed undue experimentation. In addition, in our view a
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9 fabric material (See Appendix D to the Appeal Brief).

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13 that the mesh material disclosed in Kratz is a stretch material, such mesh
14 material is not disposed in the outer elbow portion of the garment.

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